

Section 3. Remarks:

Reconsideration and re-examination of this application is respectfully requested in view of the amendments to the claims and these Remarks.

Claims 1 – 17 remain in this case. Claims 1 and 10 have been amended to correct grammatical errors and claim formatting. Please note that the last clause of main Claim 1 was overlooked in the Office Action, so it has been placed in a separate sub-paragraph to highlight that the clamp structure has opposed guide channels, item 36 in the Figures, in which the ends 50 of the yoke slide to maintain alignment of the jaw with respect to the screw and the workpiece.

Claim 17 has been amended to be dependent from Claim 3, and its grammar corrected to be in apparatus terminology rather than method language. Accordingly, the Restriction Requirement no longer applies, and Applicant requests that Claim 17 be considered to be part of the elected Group I. No new matter has been introduced, as there are no new elements added to the claim.

Response to the Art Rejections Under 35 USC §§102 and 103:

It is Applicant's position that both the anticipation and the obviousness rejections over Maes '739 and Johnson '715 are inappropriate and should be withdrawn.

Clearly, the substantive structural clause of both main claims 1 and 10 relating to the alignment guide channels have been overlooked. Both main Claim 1 and Claim 10 specifies that: "said clamp having *a pair of opposing guide channels* formed therein for slidably receiving said yoke." Those channels are identified as element 36 and the yoke tips that slide therein as 50; Fig. 5 shows:

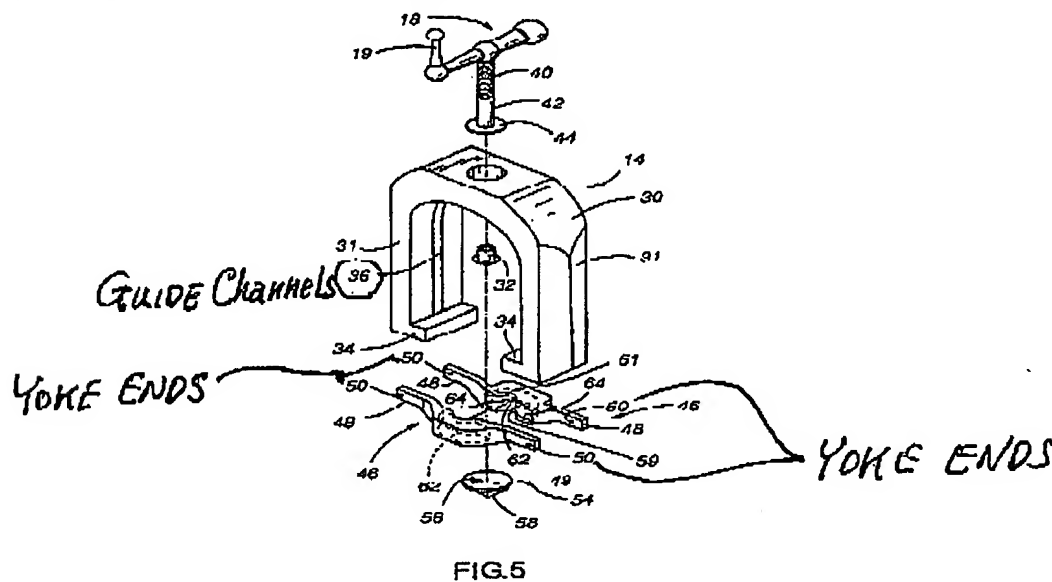


FIG.5

Since those features are not present in either reference, and have not even been referred to in the Office Action the rejection fails.

Note also that Maes '739 has no top jaw. In contrast, in the instant application the adjustable jaw assembly is shown as item 54. Note Claim 17 calls for that jaw element "... is shifted in relation to the yoke as the jaw contacts the workpiece in order to insure the jaw makes aligned contact with the work-piece." This means that in the case of off center workpieces, or out of round workpieces, the jaw can still make full, aligned contact by virtue of the cooperation of the yoke, the jaw assembly and the guide channels. No such elements are shown in the references.

To argue motivation to combine the references in the absence of any such teaching or structure in either reference is a reliance on phantom prior art. But that is improper. The Board of Patent Appeals and Interferences does not condone that approach, stating in Ex parte Stern, 13 USPQ 2d 1379 at 1381:

"The examiner should be aware that "deeming" [here, the essence of the Exam-ner arguing the jaw of Maes '739 "may obviously include a flanged arcuate jaw" on page 3, line 3 of the Detailed Action] does not discharge him from the burden of providing the requisite factual basis and establishing the requisite motivation to support a conclusion of obviousness. [Citing cases] The examiner's reference to unidentified phantom prior art techniques falls far short of the mark. [Citing cases] Accordingly, the examiner's rejection of the appealed claims under 35 USC 103 as unpatentable over any of the primary references, considered singly, is reversed."

Indeed, the Examiner here, in using the term "obviously", is assuming the conclusion. The Examiner says, *ex cathedra*, "The claims are obvious because I say they are obvious." Not only is that a circular argument, it is just plain not the law, see Ex parte Stern, *supra*.

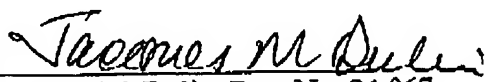
Thus, the Section 102 and 103 rejections here should be withdrawn as lacking any factual basis.

CONCLUSION

Accordingly, reconsideration allowance of all the claims is respectfully requested.

Respectfully submitted,
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End of Section 3. Remarks.

End of Response to Office Action.